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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,984	09/19/2003	Christopher McGee	020375-042800US	5376
20350	7590	04/28/2005		EXAMINER LEE, DIANE I
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ART UNIT 2876	PAPER NUMBER

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/665,984	MCGEE ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
D. I. Lee	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 37,38 and 51-66 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-36,39-50 and 67-78 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/26/04</u> .   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

1. Claims 1-78 are presented for examination.

### *Election/Restrictions*

2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: Figures 1-8 and 10, drawn to a data card having an information storage medium and at least one aperture therethrough for suspending the data card from a display hook;

Group II: Figure 9, drawn to a package of the data card in a card carrier having at least one post thereon where the data card is retained and completely encased by the card carrier by inserting the aperture onto the post.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious

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variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Ms. Nena Bains on 4/8/05 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-36, 39-50, and 67-78. Affirmation of this election must be made by applicant in replying to this Office action. Claims 37-38 and 51-666 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 12-20, 22, 31-34, 36, 40-42, 45-50, 67-69, 73-74, and 76-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Biller US [2004,0182940 A1-referred as Biller].**

**Re claims 12, 15-16, 19-20, 36, 41-42, 46, 49-50:** Biller teaches the data card (a disc 20) and the method for displaying the card via display rack, which is functionally equivalent to display hook, the data card comprising:

a data card (a disc 20) having an information storage medium (an encoding region having a magnetic stripe 70, a bar code, or any other suitable encoding) that is adapted to store a unique identifier (the encoding region comprising identification information associated with an account created for the purchaser) and at least one J-peg shaped aperture therethrough for suspending the data card from a display hook (a display hole 80 for hanging the data card on a display rack (not specifically shown) having a hook (not specifically shown)), and an additional circular aperture 110 through the data card (an aperture 110 to engage the disc to rotatable drive mechanism of an optical card reader) (see the abstract, paragraphs 31-33, 38, 43, and figures 1, 3-4 for example).

**Re claim 31-32, 45:** wherein the circular shaped data card has only one flat bottom edge and the information storage medium is located on the flat bottom edge of the data card (see figures 2 and 4) and wherein the at least one centrally spaced aperture 110 (i.e., as broadly interpreted by the examiner, “centrally spaced aperture” is any portion which lies with the perimeter of the card surface, since applicant has not specifically defined, in the claim language, that “centrally spaced aperture” must contain “the center point” of the card).

**Re claims 67-69, 74, 77-78:** figure 4 shows the data card having at least one protrusion extends from one side portion of the data card (the figure 4 shows the protrusion extends from the top of the data card) and at least one semi-circular shaped like aperture through the protrusion for suspending the data card from a display rack, which is functionally equivalent to display hook.

**Re claims 13-14:** where the J-peg shaped aperture is located on top side portion of the data card (see figures 1 and 2-4).

**Re claims 17-18, 33-34, 47-48, and 76:** wherein the data card comprises a stored value card (i.e., the card contains information related to an account such as a prepaid or debit account that allows predetermined length of time to access the Internet, phone card, a gift card, or etc. (see the abstract, paragraphs 2, 12, 33, 43 for example).

**Re claims 22, 40, and 73:** wherein the data card has a circular shape (see figures 2 and 4).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 23-29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duroj [US 2004/0182940 A1] in view of Biller.** The teachings of Biller have been discussed above.

**Re claims 23-25, 28-29:** Duroj discloses a financial presentation instrument with an integrated holder comprising:

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a rectangular shaped data card (a storage card 1, see par. 12) having an information storage medium (a circular partial segment 4, a magnetic field 5, bar codes 6, and a transponder 7, see pars. 12, 21, and figure 3) and at least one aperture (a hole 8 that is an elongated oval shape) therethrough for attached to a device (see par. 20 and figures 1-3), wherein the at least one aperture is located on a central portion (i.e., as broadly interpreted by the examiner, “a central portion” is any portion which lies with the perimeter of the card surface, since applicant has not specifically defined, in the claim language, that “a central portion” must contain “the center point” of the card); and an additional aperture (a circular aperture 3) through the data card (see figures 1-3).

Although the aperture of Duroj (i.e., the hole 8 that is an elongated oval shape that can easily adapted to place in a display rack), Duroj does not explicitly teaches that the aperture for suspending the data card from a display hook.

Biller discloses a data card having one J-peg shaped aperture (a display holder 80) therethrough for suspending the data card from a display hook in a display rack (i.e., the display hole 80 for hanging the data card on a display rack (not specifically shown) having a hook (not specifically shown)) (see par. 36).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the aperture for suspending the card to display on a display rack, as taught by Biller in order to allow the data card to place in the display rack for retailing purpose.

**Re claims 26-27:** The data card comprises a stored value card and a gift card (see pars. 20, 24).

**10. Claims 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Duroj [US 2004/0182940 A1].** The teachings of Duroj have been discussed above.

Duroj fails to specifically teach the aperture having a rectangular shape.

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However, Duroj states at paragraph 20 that the areas on the card that are not filled with information can be processed in any way chosen and anything is possible as long as it does not affect the possibility of placing the card in a reading device. Therefore, in view of Duroj's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide other shape of the aperture, such as a rectangular shaped aperture, to accommodate the hanging arrangement of the display rack. Therefore, providing the rectangular shaped aperture to the data card would have been obvious design variation of the aperture to accommodate the hanging arrangement of the display rack. Accordingly, it would have been an obvious extension, as taught by Duroj.

11. **Claims 1-9, 11, 43-44, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biller in view of Motoe [JP 2001-109859 A].** The teachings of Biller have been discussed above.

Although Biller shows at least one aperture located on a side/top portion of the data card for displaying data card on a display rack, and at least one display hole through the protrusion for hanging data card on a display rack; Biller does not teach the data card having a pair of apertures or a second protrusion with an additional aperture therethrough.

Motoe teaches the card having a plurality of holes for suspending the card from a binder.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to provide more than one aperture on the card for displaying purpose in order to provide greater stability of placement of the card on the display rack and less likely for the card to fall off from the display rack.

12. **Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biller in view of Duroj [US 2002/0006103].** The teachings of Biller have been discussed above.

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Biller does not teach the rectangular shaped data card and further fails to specifically teach the claimed dimensions of the card, i.e., the length of the card is less than about 3 3/8 inches (i.e., 3.375 inches or 76.2 mm).

Duroj teaches that the card having a rectangular shaped data card with a preferred length of 72 mm (which is less than 3 3/8 inches or 76.2 mm).

In view of Duroj's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate Duroj's preferred card length in the teaching of Biller in order to allow a maximum diameter of the circular partial segment for adapting the standard card reader (see paragraph 14 for example),

13. **Claims 21, 30, 39, and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biller in view of Schoppe [US 6,760,280].** The teachings of Biller have been discussed above.

Biller does not teach the rectangular shaped data card and further fails to specifically teach the claimed dimensions of the card, i.e., a height of the card is about or less than about 2 1/8 inches (54 mm) and the length of the card is about or less than about 3 3/8 inches (76.2 mm).

Schoppe discloses a rectangular shaped data card (an optical data card 16) having a information storage medium and the dimensions of the card is approximately equivalent to a standard chip card, i.e., a length 2 of approximately 85 mm (i.e., about or less than about 3 3/8 inches or 85.725 mm), a width 3 of approximately 54mm (i.e., about 2 1/8 inches or 54 mm) (see col. 4, lines 38+).

In view of Schoppe's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the standard size of the card in the teaching of Biller in order to allow the card to be operable with a standard magnetic stripe reading device.

14. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biller as modified by Motoe, as applied in claim 1, and further in view of Schoppe [US 6,760,280].** The teachings of Biller as modified by Motoe and teachings of Schoppe have been discussed above.

See the discussion regarding claim 21 above.

*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yen [US 2002/0066789 A1], Dilday et al. [US 6,484,940], Cheung [US 6,814,286], and Blank [US 6,588,658] discloses a data card having an information storage medium; Hansesn [US 6,708,820], Krahm [US 2002/0157974], Neal Jr. [Des. 396,882], and Rheinstein [US 2003/0233844] discloses a data card with at least one aperture therethrough for suspending the data card for display; and

Goade, Sr. [US 5,609,253] discloses an aperture for suspending the data card from a display hook.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee  
Primary Examiner  
Art Unit 2876